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OFFICE OF PETITIONS

In re REISSUE PATENT NO. RE37,894
Issue Date: October 22, 2002
Patent No. 5,494,297
Issue Date: February 27, 1996
Application No. 09/030,702
Filed: February 25, 1998
Attorney Docket No: SHAM02-00001

ON PETITION

This is a decision on the petition filed September 5, 2007, under 37 CFR 1.378(b), to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

The original patent issued February 27, 1996. The first maintenance fee due could have been paid during the period from March 1, 1999 through August 29, 1999 or with a surcharge during the period from August 30, 1999 through February 27, 2000. The second maintenance fee due could have been paid during the period from February 27, 2003 through August 26, 2003 or with a surcharge during the period from August 27, 2003 through February 27, 2004. This patent expired on February 27, 2000 for failure to timely remit the maintenance fee.

Petitioners assert that the delay in payment of the first maintenance fee was unavoidable in that in spite of their reliance upon their attorney to maintain the patent, the attorney responsible for paying the first maintenance fee did not do so, that they relied, the assignee was not aware of the non-payment of the maintenance fee and that they only learned that the maintenance fees had not been paid after notification from a third party in 2006.

A petition to accept the delayed maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate, verified showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee

would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(I)(1).

This petition lacks item (1) above.

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses identical language (i.e. "unavoidable delay").¹ Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.² In this regard:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.³

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.⁴ That is, an adequate showing that the delay was "unavoidable" within the meaning of 35

¹Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1989)).

²Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used by prudent and careful men in relation to their most important business").

³In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

⁴Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent.⁵

Petitioners have not shown unavoidable delay. The showing of record is inadequate to establish that the delay in timely paying the maintenance fees was unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

No evidence has been provided to establish that the delay by the firm charged with payment of the maintenance fee was unavoidable. Petitioner is reminded that in the absence of an adequate showing of the diligence of his representatives in this matter throughout the period in question, the actions or inactions of the registered practitioners will remain imputed to the inventors.⁶

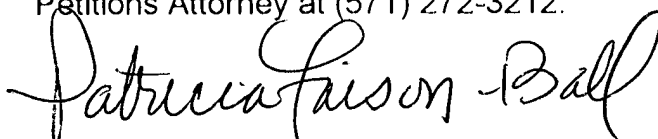
It is incumbent upon the petitioner to demonstrate, via a documented showing, that the entire delay was unavoidable which would include from the time the maintenance fee was due until the time petitioners became aware that the maintenance fee had not been paid, as well as from that point until the filing of the instant petition.

Any showing of unavoidable delay must include a statement from the principals responsible for payment of the maintenance fees as to why action was not taken to timely submit the required maintenance fee while the patent was under their control. Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
 Commissioner for Patents
 P.O. Box 1450
 Alexandria VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.



Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

⁵Id.

⁶See In re Lonardo, 17 USPQ2d 1455 (Comm'r Pat. 1990).